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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,756	01/27/2004	Robert James Salmi	1370.065US1	1941
21186 7590 06/05/2009 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER DAILEY, THOMAS J				
ART UNIT 2452		PAPER NUMBER		
NOTIFICATION DATE 06/05/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@slwip.com  
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### Office Action Summary

**Application No.**

10/765,756

**Applicant(s)**

SALMI ET AL.

**Examiner**

Thomas J. Dailey

**Art Unit**

2452

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date 5/7/2007; 2/17/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 51-132 were cancelled by the amendment filed on 2/17/2009.
2. Claims 1-50 are pending.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-13 and 27-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
5. Claims 1-13 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the

method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

6. Claim 27 is directed to, "A system comprising..." and all the limitations ("means for parameterizing," "means for applying," and "means for storing") may interpreted and implemented as software alone when read in light of the specification. Therefore the claims are directed to functional descriptive material that is not embodied on a computer system which is non-statutory.
7. Claim 40 is directed to, "A machine-readable medium that provides instructions..." As provided on pages 25, lines 6-16 of the specification, a machine-readable media includes transmission media and acoustic and light waves that are generated during radio wave communications. Claims drawn to components involving signals encoded with functional descriptive material do not fall within any of the categories of statutory subject matter as set forth in 35 U.S.C. 101, and are therefore, ineligible for protection.

8. Claims 28-39 and 41-50 depend from the above rejected claims, do not remedy those rejections, and, therefore they are similarly rejected.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 5-11, 18-24, 31-37, and 45-49 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 5, 18, 31, and 45 recite, "*the* customer or *the* customer class." Both limitations lack antecedent basis in the claims.

12. Claims 6-11, 19-24, 32-37, and 46-49 are rejected due to their dependence on the above rejected claims.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Odiaka (US Pat. 6,829,347).

15. As to claim 1, Odiaka discloses a method comprising:

parameterizing a routing policy (column 6, lines 50-59, policy profile (routing policy) contains parameters); and

applying the parameterized-routing policy to a route (column 6, lines 54-59, policy profile with defined parameters is applied to a new trail (route)).

16. As to claims 14, 27, and 40, they are rejected by a similar rationale to that set forth in claim 1's rejection.

17. As to claims 2, 15, 28, and 41 Odiaka, discloses the routing policy comprises a plurality of policy statements (column 6, lines 60-63, editor screen lists various parameters which can be selected and configured), and wherein the processor is to assign parameters to at least some of the policy statements and is to refrain from assigning parameters to at least some other of the policy statements to generate the parameterized-routing policy (column 7, lines 1-7, user controls may

control parameter assignment; column 7, Table 1 list various parameters associated with policy statements; all policy statements need not have parameters, see for example "Balancing Mode...No-Adjustment"), and wherein the processor is to store the assigned parameters in the storage element (column 6, lines 60-63).

18. As to claims 3, 16, 29, and 42, Odiaka discloses for the routing policy, generating at least one parameterized-policy statement having an associated set of parameters for one of either a customer or customer class (column 4, lines 42-43).

19. As to claims 4, 17, 30, and 43, Odiaka discloses the routing policy comprises a plurality of policy statements, each policy statement having one or more differing values associated with one or more customers or customer classes (column 6, lines 60-63 and column 7, Table 1), and wherein the processor is to assign parameters to the one or more differing values of the policy statements (column 7, Table 1).

20. As to claims 5, 18, 31, and 45, Odiaka discloses identifying one or more common blocks of policy statements within the policy (column 6, lines 60-63 and column 7, Table 1; default values read on common blocks); assigning sets of parameters to elements of the one or more common blocks (column 7, Table 1; "Default

Values"); and storing the parameter sets in a parameter table, the table associating each set of parameters with either the customer or the customer class (column 7, Table 1; further column 7, lines 17-26, defines various default policies based upon customer needs).

21. As to claims 6, 19, 32, and 47, Odiaka discloses parameterizing further comprises reusing the common blocks in the parameterized-routing policy (column 7, Table 1 and column 7, lines 17-26, i.e. class of service/default profiles)
22. As to claims 7, 20, 33, and 48, Odiaka discloses parameterizing further comprises reusing the common blocks in another parameterized-routing policy (column 7, Table 1 and column 7, lines 17-26, i.e. class of service/default profiles).
23. As to claims 8, 21, and 34, Odiaka discloses calling a parameterized policy with parameters from the parameter table based on one of either the customer or the customer class (column 7, Table 1 and column 7, lines 17-26, i.e. class of service profile (customer class)).
24. As to claims 9, 22, 35, and 49, Odiaka discloses determining at least one of whether to accept the route (column 6, lines 60-63).



25. As to claims 10, 23, and 36, Odiaka discloses when the route is accepted or modified, applying further comprises installing the accepted or the modified route (column 6, lines 60-63).
26. As to claims 11, 24, and 37, Odiaka discloses modifying attributes of the route, wherein modifying comprises at least one of changing an attribute (column 6, lines 60-63).
27. As to claims 12, 25, 38, and 50, Odiaka discloses:
- identifying one or more common blocks of policy statements, the common blocks being common to more than one routing policy (column 7, lines 9-26 and column 7, Table 1; default values read on common blocks);
  - generating a commonized routing policy from the one or more common blocks (column 7, lines 9-26 and column 7, Table 1; default values read on common blocks); and
  - reusing the commonized routing policy by calling the commonized routing policy from within the more than one routing policy which uses the common blocks (column 7, lines 9-26 and column 7, Table 1; default values read on common blocks; a profile may be reused for different trails (routes)).

28. As to claims 13, 26, and 39, Odiaka discloses assigning parameters to at least some of the policy statements of the common blocks to parameterize at least some policy statements in the common blocks (column 7, lines 9-26 and column 7, Table 1).
29. As to claim 44, Odiaka discloses parameterizing comprises assigning parameters to the one or more differing values of the policy statements (column 7, Table 1).

### ***Conclusion***

30. For additional prior art made of record and not relied upon but considered pertinent to applicant's disclosure see attached Notice of References Cited, Form PTO-892.
31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Dailey whose telephone number is 571-270-1246. The examiner can normally be reached on Monday thru Friday; 9:00am - 5:00pm.
32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. J. D./  
Examiner, Art Unit 2452

/Dohm Chankong/  
Primary Examiner, Art Unit 2452